



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

cw

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,576	10/03/2001	Michael V. Chobotov	24641-1040B	2628

20350 7590 06/04/2003

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

MILLER, CHERYL L

ART UNIT PAPER NUMBER

3738

DATE MAILED: 06/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/970,576

Applicant(s)

CHOBOTOV, MICHAEL V.

Examiner

Cheryl Miller

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 19-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 19-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 19-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

The corrected or substitute drawings were received on January 23, 2003. These drawings are approved.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 recites the limitation "The method of claim 30" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change "claim 30" to recite -- claim 32--.

### ***Double Patenting***

Claims 1 and 19-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 17-22 of U.S. Patent No. 6,331,191 B1 to Chobotov. Although the conflicting claims are not identical, they are not patentably distinct from each other because once an applicant has received a patent for a species or a more specific embodiment, he is not entitled to a patent for the generic or broader invention. The

Art Unit: 3738

patented claims "anticipate" the application claims. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 19-22, 24-26, 28, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al. (USPN 5,931,865, cited in previous office action). Silverman discloses a graft (10, 50) comprising a plurality of separate graft members (16, 18, 52, 54, 56) configured to be separately layered. (Even though the layers may be delivered simultaneously, the layers are still separate layers and once deployed, the end product is the same as claimed). Silverman discloses at least 3 graft members (52, 54, 56) wherein the layers are overlapped (fig.12, 13), and wherein the inner layer (52, 16) has the greatest axial length extending beyond the outer graft layer (fig.3). Silverman discloses the separate graft members having anchoring mechanisms at both ends and a linking means for securing separate graft members together (sutures, staples, clips, or compression causing interference fit, col.9, lines 27-30; col.3, lines 3-7).

Claims 1, 19, 21, 28-32, 35-39, and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Dereume et al. (USPN 5,639,278). See figures 7, 18-24, and respective portions

Art Unit: 3738

of the specification. Dereume discloses a graft comprising a plurality of separate graft members (101, 108, 115) configured to be separately layered. Dereume discloses at least 3 graft members (101, 108, 115) wherein the layers are overlapped (fig.24; col.10, lines 62-65). Dereume discloses the separate graft members having anchoring mechanisms at both ends and a linking means for securing separate graft members together (col.11, lines 25-30; col.12, lines 1-5). Dereume discloses at least one graft member being bifurcated (101, fig.19). Dereume discloses a multi-layered graft comprising a first graft member (101) having a membrane and support structure (fig.7; col.12, lines 6-9), one or more additional graft members (108, 115) having a membrane and support structure (fig.1; col.12, lines 6-9), wherein the additional graft is configured to be layered in situ within the lumen of the first graft forming an overlapped portion (fig.21-24; col.10, lines 63-65). Dereume discloses a method of deploying a graft in a body vessel comprising deploying a first graft member (101), delivering at two additional graft members (108, 115) within a lumen of the first graft (101), deploying the additional graft members within the lumen of the first graft forming an overlapped portion (fig.19-24; col.10, lines 21-67; col.11, lines 1-11). Dereume discloses graft members made of ePTFE (fluoroelastomers, col.13, line 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3738

Claims 23, 27, 33-34, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dereume et al. (USPN 5,639,278). Referring to claims 23, 27, and 41, Dereume discloses graft members having a thickness, a longitudinal axis and configured to expand to a transverse dimension and configured to be constrained to a transverse dimension, however does not expressly disclose specific dimensions. It would have been an obvious matter of design choice to have a thickness of .002 inches to .008 inches, an expanded dimension of up to 40 mm and a constrained dimension of about 3 mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Referring to claim 33, Dereume discloses an innermost graft and a first graft member, however does not disclose an innermost graft having a longer length to extend beyond the first graft member. It would have been an obvious matter of design choice to have a longer innermost graft, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Referring to claim 34, Dereume discloses anchoring the innermost graft at both ends (col.11, lines 25-30; col.12, lines 1-5).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3738

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl Miller

May 30, 2003

**BRUCE SNOW**  
**PRIMARY EXAMINER**